

REMARKS

In the Office Action dated October 12, 2005, typographical errors were noted in claims 3 and 14, which have been corrected.

Claims 3, 4 and 12 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for various reasons noted by the Examiner. Each of those claims has been editorially amended to overcome the indefiniteness noted by the Examiner, and all claims are therefore submitted to be in full compliance with all provisions of §112, second paragraph.

Claims 1-3, 6, 7, 9, 10, 13 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Moore in view of an excerpt of a textbook by Schneier. Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Moore in view of Schneier, further in view of Nielsen. Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over Moore in view of Schneier, further in view of Selph.

These rejections are respectfully traversed for the following reasons.

The Examiner relied on the Moore reference as teachings steps (a) through (d) and step (h) of the method of independent claim 1 of the present application, and relied on the Schneier reference as teachings steps (e) through (g). The Examiner also acknowledged that the Moore reference does not disclose that a check code accompanies the electronic message that is sent from the use location to the remote location. The Examiner stated combining the ideas of Schneier with Moore allows the electronic message that is sent from the use location to the remote location to include a digital signature, which the Examiner apparently equated with a check code. The Examiner stated it is well-known in the art, and is disclosed in the

Schneier text, that digitally signing a message provides a number of advantages, including a means to protect the authenticity of message and a means to protect the sender's identity.

Applicant's basis for traversing the rejection of claim 1 is that a digital signature as taught in the Schneier reference is not the same as a check code, and does not serve the same purpose, and additionally Applicant respectfully submits the Examiner has not provided sufficient evidence to justify the Examiner's conclusion that it would have been obvious to modify the procedure disclosed in the Moore reference to provide protection for the *contents* of the message that includes the charge for the usage of the commodity.

First, regarding the teachings of the Schneier reference, Applicant acknowledges that the Schneier reference discloses the use of a digital signature. Applicant submits, however, that the Examiner has very loosely described the purpose and function of a digital signature, and this loose (an inaccurate) description of the purpose of a digital signature has caused the Examiner apparently to equate a digital signature with a check code. The Examiner stated that a purpose of a digital signature is to "protect the authenticity of message," but the authenticity of a message either exists or does not exist, and thus does not need to be "protected." The purpose of a digital signature is to *ensure* that a message is authentic, i.e., to ensure that the message actually originates from the sender that the recipient expects. For this purpose, the digital signature is appended to the contents of the message, but does not alter or otherwise interact with the contents of the message, A digital signature, therefore, does not "protect" the actual contents of the message,

since the contents remain the same regardless of whether the digital signature is used or not.

By contrast, the purpose of a check code is to actually protect the contents of the message itself, rather than simply to indicate that the sender (origination) of the message is authentic.

Moreover, the Examiner further stated that the purpose of digital signing is to protect the sender's identity, which Applicant also submits is not correct. Particularly in the case of a wireless transmitted message, it is easy to identify the location of origin of the transmission, and thereby to identify the sender. Whether the recipient, or anyone else, knows the identity of the sender is irrelevant; the purpose of the digital signing is so that the recipient knows that the received message was actually intended to be sent by the entity identified by the digital signature, whoever or whatever that entity is.

Therefore, Applicant respectfully submits the Examiner's alleged reasons why a person of ordinary skill in the field of transmitting messages concerning charges for commodity use would have been motivated to modify the Moore procedure in accordance with the teachings of Schneier are not only factually incorrect, but are not applicable to the actual language of claim 1.

Applicant acknowledges, of course, that in general it is known to protect messages using a check code, and therefore it is possible that the Examiner may consider simply substituting a reference teaching the generation of a check code in place of the teaching of the Schneier reference to make use of a digital signature. Simply having knowledge of this general information, however, is insufficient as a matter of law to substantiate a rejection under 35 U.S.C. §103(a). Independent claim

1 of the present application requires that the contents of a message concerning commodity usage, which contents include an indication of the charge for the commodity usage, are transmitted with the protection afforded by a checksum. Applicant respectfully submits that in order to substantiate a rejection of claim 1 under 35 U.S.C. §103(a) according to the evidentiary standards established by the United States Court of Appeals for the Federal Circuit, something more than a citation of general knowledge must be provided.

The Federal Circuit stated in *In re Lee* 227 F.3d 1338, 61 U.S.P.Q. 2d 1430 (Fed. Cir. 2002):

"The factual inquiry whether to combine references must be thorough and searching. ...It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with."

Similarly, quoting *C.R. Bard, Inc. the M3 Systems, Inc.* 157 F.3d 1340, 1352, 48 U.S.P.Q. 2d 1225, 1232 (Fed. Cir. 1998), the Federal Circuit in *Brown & Williamson Tobacco Court v. Philip Morris, Inc.*, 229 F.3d 1120, 1124-1125, 56 U.S.P.Q. 2d 1456, 1459 (Fed. Cir. 2000) stated:

[A] showing of a suggestion, teaching or motivation to combine the prior art references is an 'essential component of an obviousness holding'.

In *In re Dembiczak*, 175 F.3d 994,999, 50 U.S.P.Q. 2d 1614, 1617 (Fed. Cir. 1999) the Federal Circuit stated:

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.

Consistently, in *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q. 2d 1453, 1459 (Fed. Cir. 1998), the Federal Circuit stated:

[E]ven when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill in the art, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.

In *Winner International Royalty Corp. v. Wang*, 200 F.3d 1340, 1348-1349, 53

U.S.P.Q. 2d 1580, 1586 (Fed. Cir. 2000), the Federal Circuit stated:

Although a reference need not expressly teach that the disclosure contained therein should be combined with another, ... the showing of combinability, in whatever form, must nevertheless be clear and particular.

Lastly, in *Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367,

1376, 62 U.S.P.Q. 2d 1917 (Fed. Cir. 2002), the Federal Circuit stated:

There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor.

There are so many different ways that transmitted messages can be protected, and so many different types of protectable message contents, that simply having general knowledge of different ways to protect different types of messages does not rise to the level of specificity required as a motivation, inducement or teaching to substantiate a rejection under 35 U.S.C. §103(a). The alleged motivation, teaching or inducement must be capable of actually serving as a guide to a person of ordinary skill in the relevant technology to arrive at the claimed subject matter. Applicant respectfully submits that a combination of the teachings of Moore and Schneier does not satisfy this standard, with regard to claim 1 as well as with regard to claims 2, 3, 6, 7 9, 10, 13 and 14 depending therefrom. Applicant therefore respectfully submits that none of those claims would have been obvious to a person

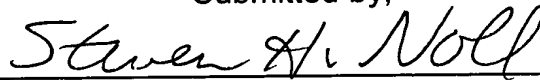
of ordinary skill in the field of protected message transmission under the provisions of 35 U.S.C. §103(a) based on the teachings of those references.

The same arguments are applicable to the rejections of claims 4 and 5, wherein the Moore/ Schneier combination was augmented with further secondary references. Even if the Examiner's statements regarding those secondary references are correct, for the above reason the Moore/ Schneier combination fails to disclose or suggest the subject matter of independent claim 1, from which claims 4 and 5 depend, and therefore neither of those claims would have been obvious for the same reasons discussed above in connection with claim 1.

Claims 8 and 11 were withdrawn from consideration as being directed to a non-elected species. Since claim 1 is a generic claim and since Applicant submits claim 1 is allowable, withdrawal of the election of species requirement is proper, and all claims of the application are submitted to be in condition for allowance.

Early reconsideration of the application is therefore respectfully requested.

Submitted by,



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